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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,367	09/02/2003	Reid Rabon	163.1436USD1	4230

7590 04/20/2005

Attention of Mark T. Skoog  
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Minneapolis, MN 55402-0903

EXAMINER

BOYER, CHARLES I

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/654,367

Applicant(s)

RABON ET AL

Examiner

Charles I. Boyer

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 6-28 and 37-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/2/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group II in the reply filed on February 28, 2005 is acknowledged. The traversal is on the ground(s) that the claims could all be searched together. This is not found persuasive because the different groups have cleaning compositions which contain completely different components.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

2. The information disclosure statement filed September 2, 2003 does not contain a copy of the foreign patent documents as these documents were submitted in the parent application, serial number 09/816695. Though the examiner has no doubt that the documents were submitted with the parent application, unfortunately, these documents are no longer in the file. Though this is almost certainly an error on the part of the Office, the examiner would be grateful if applicants could submit the foreign patent documents so that they may be considered.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 3-5, and 29-33 are rejected under the judicially created doctrine of double patenting over claims 1-5 of U. S. Patent No. 6,632,291 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The rinse compositions are identical. The only difference is the rinse composition is used in conjunction with a cleaning method in the patent, and the rinse composition stands alone as a rinse method in the application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-5 and 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lentsch et al, US 5,880,088.

Lentsch et al teach solid block rinse aids for dilution in a washing machine and subsequent rinsing of utensils (see abstract). Lentsch et al specifically teach that “The liquid materials of the invention can be adapted to a solid block rinse by incorporating into the composition a casting agent. Typically organic and inorganic solidifying materials can be used to render the composition solid. Preferably organic materials are used because inorganic compositions tend to promote spotting in a rinse cycle. The most preferred casting agents are polyethylene glycol and an inclusion complex comprising urea and a nonionic polyethylene or polypropylene oxide polymer. Polyethylene glycols (PEG) are used in melt type solidification processing by uniformly blending the sheeting agent and other components with PEG at a

temperature above the melting point of the PEG and cooling the uniform mixture” (col. 11, lines 8-20, emphasis added by the examiner). An example of such a composition comprises 73% EO/PO block polymer, silicone antifoam, and 16% urea (col. 16, example 5). The EO/PO polymers taught by the reference appear to be the same as those presently claimed (see col. 7, lines 36-52). Accordingly, Lentsch et al appear to teach the exact same rinsing composition as claimed by applicants, the only difference being the rinse aid of the reference is used for rinsing cookware and the present claims are drawn to rinsing medical equipment. The examiner maintains that the medical equipment as broadly defined in the present claims overlaps the utensils taught by the reference. For example, an “instrument or device” as claimed could refer to almost anything, and note that the rinse aid of the reference is used to rinse plastic, glass, and stainless steel (col. 17, table 5), any of which materials could be used in medical applications. Accordingly, one of ordinary skill in the art would recognize the utility of the rinse aid of the reference for rinsing other types of utensils, including medical equipment, given the fact that a great deal of medical equipment is formulated from plastic, glass, and stainless steel, the very materials Lentsch et al teach as being effectively rinsed by their rinse aid composition.

7. Claims 3, 4, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz et al, US 5,698,513.

Schulz et al teach solid block rinse aids for dilution in a washing machine and subsequent rinsing of utensils (see abstract). An example of such a composition comprises 84.48% EO/PO block polymer, 12% urea, and 3.5% water (col. 14, example 2). Accordingly, Schulz et al appear to teach the exact same rinsing composition as claimed by applicants, the only difference being the rinse aid of the reference is used for rinsing cookware and the present claims are drawn to rinsing medical equipment. The examiner maintains that the medical equipment as broadly defined in the present claims overlaps the utensils taught by the reference. For example, an “instrument or device” as claimed could refer to almost anything, overlapping utensils also used as cookware, for example knives, trays, and pans. Accordingly, one of ordinary skill in the art would recognize the utility of the rinse aid of the reference for rinsing other types of utensils, including medical equipment, based on this natural overlap.

8. Claims 3, 5, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richter et al, US 5,234,719.

Richter et al teach microbicidal compositions for sanitizing food contact surfaces in health care environments (col. 1, lines 9-11). An example of such a composition is a solid formation that is diluted with water and comprises 12.81% EO/PO block polymer, octanoic acid (satisfies the defoamer limitation), 60% urea,

Art Unit: 1751

and 8% propylene glycol (col. 15, table 7 and col. 18, claim 18). Richter et al do not specifically teach a method of rinsing medical equipment, however, as Richter et al contemplate their composition for use in health care environments, it would have been obvious to one of ordinary skill in the art to use the composition for this purpose.

9. Claims 3, 5, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull, US 5,310,549.

Bull teaches germicidal compositions for use in health care environments (col. 1, lines 5-10). An example of such a composition is a solid formation that is diluted with water and comprises 10% EO/PO block polymer, coconut fatty acid (satisfies the defoamer limitation), 48.8% urea, and at least 5% water (col. 9, example 7). Bull does not specifically teach a method of rinsing medical equipment, however, as Bull contemplates her composition for use in health care environments, it would have been obvious to one of ordinary skill in the art to use the composition for this purpose.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-F 9:30 to 6:00.



Art Unit: 1751

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571 272 1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charles I Boyer  
Primary Examiner  
Art Unit 1751